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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/660,502    09/12/00    NAKAYAMA

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NEW YORK NY 10112

EXAMINER

LUCAS, M

ART UNIT

PAPER NUMBER

2873  
DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/660,502

Applicant(s)

Nakayama

Examiner

Michael A. Lucas

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-33 is/are allowed.
- 6) ☒ Claim(s) 2-15 and 21 is/are rejected.
- 7) ☒ Claim(s) 16-20 and 22-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-15, and 21, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No.(6154322) in view of Yahagi (6014268).

Claims 1-22 of US Patent 6154322 disclose the apparatus of claims 2-15 and 21 of the current application except for an image stop that moves with the second lens unit and an image pickup. In the same field of endeavor Yahagi teaches a two unit zoom lens where the image stop moves with the second lens unit (Figure 2) and an image

pickup (Column 2, lines 50-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the image stop that moves with the second lens unit of Yahagi in the apparatus of Patent 6154322 for the purpose of reducing lens flare and to use the CCD of Yahagi for the purpose of viewing the image of the device of Patent 6154322.

***Allowable Subject Matter***

Claims 16-20, 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27-33 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claim(s), in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in dependent claim 16, which includes the first lens unit having two negative lens elements, the lens element with the smaller diameter having an aspheric surface. The prior art fails to teach a combination of all the claimed features as presented in dependent claim 17, which includes the second lens element consisting of two lens elements with both the surface closest to the object side and the surface closest to the image side are aspherical. The prior art fails to teach a

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combination of all the claimed features as presented in dependent claim 18, which includes the second lens element consists of one lens element with both the surface closest to the object side and the surface closest to the image side are aspherical. The prior art fails to teach a combination of all the claimed features as presented in dependent claim 19, which includes the second lens element consisting of three lens elements with the surface closest to the object side is aspherical. . The prior art fails to teach a combination of all the claimed features as presented in dependent claim 22, which includes the second lens element consisting of a positive lens element, a negative lens element, a negative lens element, and a positive lens element. The prior art fails to teach a combination of all the claimed features as presented in dependent claim 25, which includes the second lens element consisting of three positive lens elements and a negative lens element. The prior art fails to teach a combination of all the claimed features as presented in dependent claim 26, which includes the second lens element consisting of three lens elements with the surface closest to the object side is aspherical.

### **Reasons For Allowance**

The following is an examiner's statement of reasons for allowance:

The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claim(s), in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claim 27 which

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includes the first lens unit having a positive lens element closest to the object side. .

The prior art fails to teach a combination of all the claimed features as presented in independent claim 28, which includes the first lens unit consisting of two positive lens elements and two negative lens elements. The prior art fails to teach a combination of all the claimed features as presented in independent claim 29, which include the first lens unit consisting of a positive lens element, a second negative lens element, a third negative lens element, and a fourth positive lens element. The prior art fails to teach a combination of all the claimed features as presented in independent claim 32, which includes the second lens unit consisting of three positive lens elements and a negative lens element. The prior art fails to teach a combination of all the claimed features as presented in independent claim 33, which includes the second lens unit consisting of a positive lens element, a positive lens element, a negative lens element, and a positive lens element.

### ***Response to Arguments***

Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued with respect to claim 13 that neither the claims of Nakayama nor the patent of Yahagi suggest an aperture stop between the first and second lens unit, where the second lens element has fewer lens elements than the first lens unit, the first lens unit having between three and four lens elements. Claim 12 of Nakayama teaches a second lens element has fewer lens elements than the first lens unit, the first

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lens unit having between three and four lens elements. Figure 2 of Yahagi teaches an image stop disposed between the first lens unit and the second lens unit.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Lucas whose telephone number is (703) 306-3441. The examiner can normally be reached on M-F Approx. 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-7721 for regular communications and (703) 308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MAL

October 1, 2001

A handwritten signature in black ink, appearing to read "Georgia Epps", written in a cursive style.

Georgia Epps  
Supervisory Patent Examiner  
Technology Center 2800